

REMARKS

Claims 1 to 25 are pending in the application. Applicants have file herewith a Notice of Appeal in response to the Final Office Action mailed February 6, 2003.

The present claims are directed to multilayer decorative sheets. The sheets comprise:

- (a) a clear coat having a first and second surface,
- (b) a tie coat layer on the second surface of the clear coat,
- (c) a fade print layer on the tie coat layer, and
- (d) a pressure sensitive adhesive layer on the fade print layer.

Opacity of the fade print layer reduces over the width of the decorative sheet. When used on a vehicle, the vehicle's color under the decorative sheet is revealed allowing the color of the decorative sheet to "fade into" the color of the surface under the decorative sheet.

I. The Art Rejections:

Claims 1 to 6, 8 to 10 and 16 have been rejected under 35 U.S.C. §103(a) over Johnson et al. (U.S. Patent No. 5, 518,786) alone, or in view of Ellison (U.S. Patent No. 5,985,079). The Examiner indicates that the color layer of Johnson et al. is used for decorative purposes and that a fade coat or fade print layer is inherently one type of color coat. The Examiner stated that it is conventional and clearly within the skill of the art to print a fade print layer as a color coat.

Ellison is cited as teaching methods of applying decorative effects such as printing, tinting, etc. It is considered by the Examiner to be obvious to print Ellison's color design as a fade print coat in Johnson's decorative sheet. The alleged motivation is the desire to provide decorative fade color designs.

Johnson et al. relate to exterior automotive laminate, pressure sensitive adhesive sheets. Johnson et al. teach a clear coat layer, tie coat layer, and a color coat. The color coat has adhesive applied to its back surface to adhere the surface to an automotive vehicle. Johnson et al. teach, at column 11, lines 16 to 17, that the color coat is preferably cast directly onto the tie coat layer, as opposed to forming a color coat as a separate film and then laminating it to the tie coat.

The objective stated in Johnson et al. is to find beneficial ways to eliminate the painting steps carried out in the manufacturing of conventional automobiles (see Johnson et al. – Field of the Invention). Johnson et al. teach that the painting process traditionally used for painting automobiles involves spraying and dipping. These processes provide a single color to the article. Johnson et al. seek to replace regular paint coat with an exterior automotive laminate. Further, Johnson et al. do not specifically disclose, teach or suggest a fade print layer. Johnson et al. teach that the color coat layer is preferably coated onto the tie coat layer. There is no disclosure, teaching or suggestion within Johnson et al. of how to make or to a fade print layer that permits the color of a decorative sheet to “fade into” the underlying substrate’s color on a vehicle. Nor is there any disclosure or suggestion as to why a fade print layer would be desirable.

The Examiner contends that the use of a fade print layer is considered to be inherently a type of color coat. There is no specific evidence provided by the Examiner or scientific argument given that would support the Examiner’s contention. In particular, there is no teaching or suggestion within Johnson et al. that would lead one of skilled in the art to recognize that a fade print layer is present within the generic description of the color laminate of Johnson et al. In particular, Johnson et al. do not teach a process to make the fade print layer or provide any motivation to make such a fade print layer.

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. In re Rijckaert, 28 USPQ.2d 1955, 1957 (Fed. Cir. 1993). To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." In re Roberstson, 49 USPQ2d 1949 (Fed. Cir. 1999). Furthermore, it is well settled that "[i]nherency . . . may not be established by probabilities or possibilities. There mere fact that a certain thing may result from a given set of circumstances is not sufficient." Id. quoting In re Oelrich, 212 USPQ 323, 326 (CCPA 1981).

In this case, there is no teaching in Johnson et al. that would lead one skilled in the art to recognize that a fade print layer would necessarily result from the color coat layer of Johnson et al. The cited art, not Applicants' specification, must contain a teaching that would lead a skilled person to determine that the fade print layer will necessarily result from a color coat. Such disclosure is lacking in Johnson et al.

Regarding Ellison, the Examiner has cited Ellison as teaching methods of applying decorative effects. Ellison relates to flexible composite surfacing films and methods for producing the same. Ellison teaches a flexible composite surfacing film for providing a substrate with a desired surface characteristic. The film comprises a flexible temporary carrier film and a flexible transparent outer polymer clear coat layer releasably bonded to a temporary character film, and a flexible outer polymer layer comprising extruded thermoplastic polymer. A pigmented base coat is adhered to the outer clear coat layer and is visible throughout.

The Examiner cites the paragraph at column 7, line 54 to 58 as teaching that the decorative effects may be applied by processes such as printing, tinting, vacuum metallizing, vacuum metallizing with tinting or vacuum metallizing with hologram printing.

Contrary to the Examiner's position, Ellison does not make up for the previously described deficiencies of Johnson et al. Specifically, Ellison provides no motivation to one of ordinary skill in the art to produce a fade print layer. Ellison does not disclose, teach or suggest fade print layers as decorative effects. In addition, there is no teaching or suggestion in Ellison of how one would produce a fade print layer. Nor is there any disclosure or suggestion as to why a fade print layer would be desirable. Therefore, Ellison fails to provide the motivation necessary for one of ordinary skill in the art to modify Johnson et al. to make a fade print layer. Therefore, the Applicants respectfully submit that claims 1 to 6, 8 to 10 and 16 are patentable over Johnson et al. alone or in combination with Ellison.

With respect to the Examiner's rejection of claims 1 to 6, 8 to 10 and 16 based on the combination of Johnson et al. and Ellison, it appears that the Examiner is attempting to pick and choose certain elements of each reference and combining them to yield the presently claimed invention. It is well settled that such picking and choosing involves the impermissible use of hindsight in an attempt to reconstruct the claimed invention. More specifically, the Examiner merely identifies certain claimed elements in the cited art and then alleges that the elements can be combined. The Federal Circuit ruled in In re Dembiczak, 50 USPQ2d 1614 (Fed. Cir. 1999) that "combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability [which is] the essence of hindsight". The Federal Circuit continued on to state:

. . . that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. . . . [and that such a] showing must be clear and particular.

Additionally, the Federal Circuit stated that the requirement for actual evidence is not diminished by the knowledge that the Examiner attributes to one of ordinary skill in the art. Since such motivation and, more importantly, actual evidence is clearly lacking in the cited art, the Examiner cannot use the Applicants' own disclosure as the basis to combine various claimed elements.

In particular, both Johnson et al. and Ellison fail to disclose or suggest a fade print layer as claimed by Applicants. None of the cited art disclose or suggest a change of opacity across a decorative sheet. Johnson et al. and Ellison both fail to provide the necessary motivation, whether taken alone or in combination, for one of ordinary skill in the art to make a fade print layer. Neither Johnson et al. nor Ellison contain the necessary disclosure that would teach or suggest to one of ordinary skill in the art how to make the fade print layer.

Claims 11 to 15 and 17 to 25 have been rejected under 35 U.S.C. § 103 over Johnson et al. in view of Carroll Jr. (U.S. Patent No. 5,192,609). Carroll et al. relate to a thermoformable sheet material comprising a carrier film having a dark base coat layer and over the base coat layer, a transparent layer which contains light reflective metallic flakes and over the metallic flake layer a clear top coat layer.

Carroll et al. do not teach or suggest the fade print layer. Carroll et al. does not make up for the deficiencies already described for Johnson et al. Specifically, there is no motivation in Johnson et al. or Carroll Jr. to produce a fade print layer. Applicants, therefore, submit that claims 11 to 15 and 17 to 25 are patentable over Johnson et al. in view of Carroll Jr.

Claim 7 has been rejected under 35 U.S.C. §103 over Johnson et al. alone, or in view of Alexander et al. (U.S. Patent No. 4,533,704). The Examiner again admits that Johnson et al. do not specifically teach that the clear coat is a polyester film. The Examiner then indicates that Alexander et al. is evidence of the fact that urethane-modified polyesters are used as clear coats in situations where excellent adherence to

metal and plastic substrates, as well as, superior weathering properties are desired. Specifically, the clear coat composition of Alexander et al. is a hydroxy-containing urethane-modified polyester. Alexander et al. fail to disclose, teach or suggest a fade print layer. Therefore, Alexander et al. fail to cure the deficiencies of Johnson et al.

Claim 7, which depends from claim 1, is directed to a multilayer decorative sheet wherein the clear coat layer is a polyester. Since both Johnson et al. and Alexander et al. fail to disclose or suggest a fade print layer as recited in claim 1, neither reference, taken alone or in combination, can render obvious claim 7.


In view of the above comments, the Applicants submit that the present claims are patentable over the art of record. Applicants respectfully request the Examiner to withdraw the rejections and allow claims 1 to 25.

Should the Examiner believe that a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact Applicants' undersigned attorney at the telephone number listed below.

In the event any fees are due in connection with the filing of this document, the Commissioner is authorized to charge those fees to our Deposit Account No. 18-0988 under Attorney Docket No. AVERP2580USA.

Respectfully submitted,

RENNER, OTTO, BOISSELLE & SKLAR, L.L.P.

By 
William C. Tritt
Reg. No. 32,510

1621 Euclid Avenue
Nineteenth Floor
Cleveland, Ohio 44115
Telephone: (216) 621-1113
Facsimile: (216) 621-6165